

Notice of Allowability

Application No.

10/698,510

Examiner

Maury Audet

Applicant(s)

GRASSO ET AL.

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 09/28/2006.
2. ☒ The allowed claim(s) is/are 1-5, 7-16 and 28-32.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Charles Bell, Applicant's Representative, on 09/29/06.

Election/Restrictions

This application is in condition for allowance except for the presence of Group II, claims 17-27 directed to a method of use of SEQ ID NOS: 2 or 18, in D-form, non-elected without traverse, on 5/3/06. On 09/29/06, Charles Bell, Applicant's Representative, elected not to rejoin Group II, with the intent of pursuing such in a divisional application.

Thus, the restriction requirement has been removed.

Accordingly, claims 17-27 been cancelled without prejudice.

IN THE CLAIMS

In claim 1, line 1, the term "comprising" has been deleted, and the phrase --consisting of-- inserted.

In claim 5, line 1, the numeral "1" has been deleted, and --28-- inserted therein.

In claim 13, line 4, the phrase "; all [D]-OB3; and [D-Leu-4, D-Pro-5]-OB3" has been deleted.

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In claim 15, line 1, the phrase "said peptide" has been deleted, and --the amino acid at position 4 of SEQ ID NO: 2 or 18-- inserted.

In claim 15, line 2, the term "-OB3" has been deleted.

In claim 16, line 1, the phrase "said peptide" has been deleted, and --the amino acid at position 5 of SEQ ID NO: 2 or 18-- inserted.

In claim 16, line 2, the term "-OB3" has been deleted.

In claim 28, line 1, the term "An" has been deleted, and --The-- inserted.

In claim 28, line 1, the phrase "comprising [D-Leu-4]-OB3" has been deleted, and --of claim 1--inserted.

In claim 28, lines 2-3, the phrases "serum insulin levels," and "in an obese mouse" have been deleted.

In claim 29, line 1, the phrase "polypeptide reduces" has been deleted, and --reduction in-- inserted.

In claim 29, line 2, after the term "levels", the term --occurs-- has been inserted.

In claim 29, line 2, the phrase "in an obese mouse" has been deleted.

In claim 30, line 2, the phrase "in an obese mouse" has been deleted.

Claims 6, and 17-27 been cancelled without prejudice.

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IN THE SPECIFICATION

On page 14, line 18, after the phrase (¹¹⁶Ser-Cys-Ser-Leu-Pro-Gln-Thr¹²²), the phrase --(SEQ ID NO: 2)-- has been inserted.

On page 52, line 14, after the phrase (¹¹⁶Ser-Cys-Ser-Leu-Pro-Gln-Thr¹²²), the phrase --(SEQ ID NO: 2)-- has been inserted.

On page 93, line 12, under Table 15, the phrase "Amino acid sequences of [D-Leu-4]-OB3 and its related analogs" has been deleted, and --Related analogs amino acid sequences of [D-Leu-4]-OB3—inserted.

On page 93, Table 15, after the phrase:

"Ser-Cys-Ser-Leu-Pro-Gln-Thr-Ser-Gly-

Leu-Gln-Lys-Pro-Glu-Ser", the phrase --(SEQ ID NO: 12)-- has been inserted.

On page 93, Table 15, after the phrase "Ser-Cys-Ser-Leu-Pro-Gln-Thr", the phrase --(SEQ ID NO: 2)-- has been inserted.

On page 93, Table 15, the phrase "[D-Leu-4]-OB3 Ser-Cys-Ser-[D-Leu]-Pro-Gln-Thr", has been deleted.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance: following the filing of a Terminal Disclaimer over US 6,777,388, directed to the native L-form of products to SEQ ID NO: 2 or 18, and amendment of the claims to the transition phrase of "consisting of" SEQ ID NO: 2 or 18 (the elected invention), product claims 1-5, 7-16, and 28-32 are no longer reasonably taught or suggested by the prior art of record.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion


Claims 1-5, 7-16, and 28-32 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 09/29/2006


CHRISTOPHER R. TATE
PRIMARY EXAMINER